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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,813	01/21/2004	Theresa Ernest	1008.03	1004

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EXAMINER

HUYNH, KHOA D

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.		Applicant(s)	
	10/761,813		ERNEST ET AL.	
	Examiner		Art Unit	
	Khoa D. Huynh		3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) 3,13-17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5-12 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/21/04 & 9/6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Subspecies B1 (as depicted in Fig. 13) in the reply filed on 12/08/2005 is acknowledged.

Applicant, in the reply, indicates that claims 2, 5-12 and 18 are readable on the elected subspecies. Accordingly, claims 3 and 13-19 are withdrawn from further consideration as being drawn to the non-elected inventions.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson (5301806).

Regarding claim 2, the Olson reference discloses a disposable waste collection device (Fig. 5). The device includes an absorbent pad (54), a waterproof bag (12,14) attached to the absorbent pad. The waterproof bag further includes a sheet of absorbent material (50,52) positioned on an external surface thereof on a side where the absorbent pad is attached. The absorbent pad is being centered on said sheet of absorbent material (Fig. 6). The waterproof bag further comprising first and second extensions (32,34) positioned so as to permit the closure of the waterproof bag by tying said first and second

extensions together after said waterproof bag has been inverted so as to enclose said absorbent pad and said sheet of absorbent material (col. 1, lines 62-68; col. 3, lines 62-68).

Regarding claim 5, the Olson reference discloses a disposable waste collection device (Fig. 5). The device includes an absorbent pad (54) having a capacity to absorb a urinary discharge from a person, and a waterproof bag (12,14) attached to the absorbent pad. The absorbent pad is capable of being configured to position against the urinary area of the person.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. (6514602) in view of Oster (5473789).

Regarding claim 5, the Zhao et al. reference discloses a disposable absorbent pad (20) having a shape generally contoured to be positioned against and enclose the urinary area of a person (Figs. 4 & 5). The pad is used to intercept the flow of menses, urine and other bodily exudates from the user vaginal orifice and urethra (col. 14, lines 17-19). The Zhao et al. reference also discloses that the pad can be of any size and capacity to accommodate user ranging from infants to adults (col. 13, lines 6-8).

The Zhao et al. reference DIFFERS in that the pad does not include a waterproof bag as claimed. Attention, however, is directed to the Oster reference which discloses an absorbent pad (at 22) used in conjunction with a waterproof bag or glove (about 19, 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Zhao et al. device by employing a waterproof bag or glove, in view of the teaching of Oster, in order to prevent the user's hand to come into contact with the waste fluid, i.e. urine.

Regarding claim 6, as shown in Figure 4 of the Zhao et al. reference, the shape of the absorbent pad is concave.

Regarding claim 7, as shown in Figure 4 of the Zhao et al. reference, the shape of absorbent pad is ovoid.

6. Claims 8-12, as presently and best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Zhao et al. (as discussed supra) in view of Osborn, III et al. (5885265).

Regarding claim 8, the modified Zhao et al. pad further includes a waterproof (impervious) layer or lining (about 38) and a layer of absorbent material (about 44). The Zhao et al. reference also discloses that the layer of absorbent material can be made from a variety of materials including absorbent gelling material (col. 12, lines 50-67). The Zhao et al. reference DIFFERS in that the pad does not include panels as claimed. Attention, however, is directed to the Osborn, III et al. reference which discloses a similar absorbent pad for

positioning against and enclose the urinary area of a person (Fig. 7). The pad includes a waterproof (impervious) layer or lining (about 30) and panels of absorbent material (29, 32 in Figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the modified Zhao et al. device by employing panels of absorbing material, in view of the teaching of Osborn, III et al., in order to increase the absorbent capacity of the pad.

Regarding claims 9-11, the modified Zhao et al. reference DIFFERS in that the panels do not specifically include non-woven sponge-like material and so on as claimed. It, however, would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the modified Zhao et al. panels by employing sponge-like material since the use of sponge-like material and so on is well known in the art, especially since both Zhao et al. and Osborn, III et al. also discloses that the absorbent materials can be made from a variety of materials (for instance in Zhao et al., col. 12, lines 50-67, in Osborn, III et al., col. 6, lines 4-33, also see cited Sutton et al., col. 2, lines 54-58; also applicant's admission in the specification, page 9, lines 1-2).

Regarding claim 12, as schematically shown in Figure 2, the panels of absorbent material are configured longitudinally in the pad.

7. Claims 5-7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. (6514602) in view of Olson (EP 0788327).

Regarding claim 5, the Zhao et al. reference discloses a disposable absorbent pad (20) having a shape generally contoured to be positioned against and enclose the urinary area of a person (Figs. 4 & 5). The pad is used to intercept the flow of menses, urine and other bodily exudates from the user vaginal orifice and urethra (col. 14, lines 17-19). The Zhao et al. reference also discloses that the pad can be of any size and capacity to accommodate user ranging from infants to adults (col. 13, lines 6-8).

The Zhao et al. reference DIFFERS in that the pad does not include a waterproof bag as claimed. Attention, however, is directed to the Olson reference which discloses an absorbent pad (at 54) used in conjunction with a waterproof bag (14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Zhao et al. device by employing a waterproof bag, in view of the teaching of Olson, in order to prevent the user's hand to come into contact with the waste fluid, i.e. urine.

Regarding claims 6, 7 and 18, as shown in Figure 4 of the Zhao et al. reference, the shape of the absorbent pad is ovoid, concave configured to collect urine discharged from a person. Furthermore, the Olson reference also discloses that the waterproof bag further comprising first and second extensions (32,34) positioned so as to permit the closure of the waterproof bag by tying said first and second extensions together after said waterproof bag has been inverted so as to enclose said absorbent pad.

8. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Zhao et al. (as discussed supra) in view of Osborn, III et al. (5885265).

Regarding claim 8, the modified Zhao et al. pad further includes a waterproof (impervious) layer or lining (about 38) and a layer of absorbent material (about 44). The Zhao et al. reference also discloses that the layer of absorbent material can be made from a variety of materials including absorbent gelling material (col. 12, lines 50-67). The Zhao et al. reference DIFFERS in that the pad does not include panels as claimed. Attention, however, is directed to the Osborn, III et al. reference which discloses a similar absorbent pad for positioning against and enclose the urinary area of a person (Fig. 7). The pad includes a waterproof (impervious) layer or lining (about 30) and panels of absorbent material (29, 32 in Figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the modified Zhao et al. device by employing panels of absorbing material, in view of the teaching of Osborn, III et al., in order to increase the absorbent capacity of the pad.

Regarding claims 9-11, the modified Zhao et al. reference DIFFERS in that the panels do not specifically include non-woven sponge-like material and so on as claimed. It, however, would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the modified Zhao et al. panels by employing sponge-like material since the use of sponge-like material and so on is well known in the art, especially since both Zhao et al. and

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Osborn, III et al. also discloses that the absorbent materials can be made from a variety of materials (for instance in Zhao et al., col. 12, lines 50-67, in Osborn, III et al., col. 6, lines 4-33, also see cited Sutton et al., col. 2, lines 54-58; also applicant's admission in the specification, page 9, lines 1-2).

Regarding claim 12, as schematically shown in Figure 2, the panels of absorbent material are configured longitudinally in the pad.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,912,737 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because, for instance, the difference between the patented claim 1 and the instant claim 5 are minor and obvious from each other. The instant claim 5 is a broader version of the patented claim (i.e. the instant claim 5 does not include the limitation of an absorbent rim composed of woven fiber cord as claimed in the patented claim 1). Therefore, the patented claim 1 would read on the instant claim 5. Furthermore, in the instant claim 5, the claimed limitations can be found in the patented claim 1. Any infringement over the patented claim 1 would also infringe over the instant claim 5. Hence, the instant claim does not differ from the scope of the patented claim 1. In 214 USPQ 761, *In re Van Ornum and Stang*, broad claims in an application were held to be obvious double patenting over previous narrow claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Khoa D. Huynh', with a horizontal line underneath.

Khoa D. Huynh
Primary Examiner
Art Unit 3751

HK
01/31/2006